Maguire, Lindsay M.

From: Boundy, David [DBoundy@cantor.com]
Sent: Monday, December 22, 2008 7:30 PM
To: Maguire, Lindsay M.
Cc: Abdi, Kambiz; Coggins, Wynn
Subject: 09/818,483 - can we please observe examination procedure?

Re 09/818,483

Dear Examiner Maguire:

I write to request one of two things: either withdrawal of your paper of November 24, 2008, or a telephone interview.

In the event you opt for a telephone interview, here is the agenda. Almost all of these issues have been raised in my papers, and you have failed to respond. Since you have declined to respond in papers, we will have to complete them all in a telephone interview.

To prepare, please focus on claims 14 and 190 as the representative claims, and the dictionary definition of "repurchase agreement" that I have given you in several of my papers. I cannot see how claims 14 and 190 are different enough from each other to permit restriction. The "difference" you identified in your papers is that one claim uses the term "repurchase agreement," and the other uses the term "repurchase agreement" and states the definition of a repo explicitly. You may recall that you disagreed with prior counsel on whether or not to rely on the art's ordinary definition of the term. To eliminate this issue, I simply put the definition in the claim itself. I'm at a loss to see how this can rise to a difference worth a restriction. I've pointed this out to you several times, and your responsive papers have been dead silent.

Because you seem to be unwilling to "answer all material traversed" on paper, I suggest a telephone call.

Item 1. In your paper of Nov 16, 2007, at the bottom of page 3, you explained what you believed to be the difference between the two groups of claims. I have pointed you several times to dictionary definitions showing that claims 14 and 190 use your two different sets of words to say the same thing. The two "different" sets of claim language that you identified are synonyms. Your two subsequent papers have been silent in reply. Is there a reason you failed to "Answer All Material Traversed?"

Item 2. Please explain why amending claim 190 by adding language making explicit the ordinary definition of the term "repurchase agreement" makes the claim an "independent and distinct invention."

About three weeks ago, in a telephone conversation with SPE Abdi on an unrelated issue, we incidentally discussed this application. Mr. Abdi told me that you had conferred with him, but that you had not shown him the dictionary definition that confirms that the two groups of claims are directed to essentially identical inventions (at least for restriction purposes). Obviously that's an issue between you and Mr. Abdi, not for me, but the two of you should discuss the importance of including the critical fact, and the specific claim language, as part of your question if you hope to get a reliable and helpful answer.

Item 3. Please explain whether you agree or disagree with the dictionary definition I provided you, and if you disagree, please identify the basis for your disagreement.

Item 4. I have asked you several times to make a showing of "serious search burden." You have not done so, nor have you explained your failure to do so. Please explain why you have declined to "answer all material traversed."

Item 5. There are several different independent claims. Please explain why you have not considered the claim language of the independent claims.

Item 6. I have asked several times that you consider the claim language. Your most recent paper again contains a haphazard and incorrect paraphrase of the claim language. Please explain the basis for imposing a requirement that is not based on the claim language.

Item 7. You have never considered the claim language of claim 190. Please explain the basis for restricting between claims 14 and 190. How are they "independent and distinct?" How is there "serious search burden" between claims 14 and 190?

Item 8. Please explain how a restriction requirement can ever be proper without a showing of "serious search burden."

Item 9. Please explain how stating explicitly the conventional definition for a term can create a "serious search burden."

Item 10. I have pointed out that the statute only permits restriction between claims that "are pending," in the present tense. If you believe that a restriction between claims that are pending and claims that are not pending is authorized by statute, please identify the legal authority for that position. There are several ways to answer this question: a formal decision of the Director, or a statement to that effect from the Office of the Deputy Commissioner for Patent Examination Policy, or the Office of Patent Legal Administration, or the Office of General Counsel, or some other entity within the Office that has the authority to opine on the Office's view of the law. I do not believe that the Office has ever interpreted the statute that way, but I'm willing to be shown otherwise.

Item 11. In my paper of October 8, 2007, I referred you to a memorandum from the Executive Office of the President to all agencies, at

http://www.whitehouse.gov/omb/memoranda/fy2007/m07-07.pdf

An important point reiterated throughout the President's memorandum is that agency guidance documents, such as the MPEP, can only limit the authority of agency employees ("as a matter of [an agency's] supervisory powers over [their] employees") but cannot limit the rights of the public, or create new duties (because guidance documents are not promulgated under the requirements of the Administrative Procedure Act). I pointed you to the Foreword of the MPEP, which states that the MPEP does not have force of law. For several consecutive papers, you have declined to rely on any rule that has force of law. Your subsequent papers have either relied only on your personal opinion, with no citation to any authority, or to the MPEP, which - at the instruction of the Department of Commerce and the PTO - does not have force of law. You have not "answered all material traversed." Please explain both the failure to answer all material traversed, and your apparent unwillingness to follow instructions from the President. I think I know the law in this area pretty well - you may have seen my name on several of the patent blogs two weeks ago in connection with the demise of the Appeal Rule - so I think I'm asking you only to do what the law requires, and no more.

I hope you understand that my ethical obligations to my client do not permit me to allow you to diminish my client's valuable property rights when you are acting – from all I can see – either by illegally acting beyond the authority granted you by the Office, or by simple carelessness.

But I'm also perfectly willing to be shown that I'm wrong. The only thing I can't work with from you is silence. I've put these positions before you several times, and you have not engaged with the claim language, the dictionary definition, the law or the issues raised in my papers. This has blocked progress. So now it's time to ask you to either withdraw the Nov. 24 paper, or let's schedule an interview.

Thank you.

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